

REMARKS

Claims 2, 5-10, 12, and 16, and amended claims 1 and 4 are in this application.

Claims 1, 2, 4-10, 12 and 16 were rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,589,892 (Knee et al.), U.S. Patent No. 5,047,867 (Strubbe et al.), and U.S. Patent No. 6,424,790 (Ishii et al).

Amended independent claim 1 now recites in part as follows:

“wherein the information pertaining to the respective recording medium on which the respective program is recorded and the respective start position and end position thereof on the respective recording medium and the command area **are all simultaneously displayable on a single image** so as to be viewable by the user.” (Underlining and bold added for emphasis.)

It is respectfully submitted that none of the portions of neither Knee, Strubbe, nor Ishii relied on by the Examiner for teaching the above feature of claim 1 specifically disclose the above feature. In fact, and as best understood, the Examiner appears to acknowledge that none of Knee, Strubbe, and Ishii teach the above feature of claim 1.

In an attempt to overcome the above-mentioned deficiency, the Examiner appears to assert that it would have been obvious to combine and/or modify the system of Knee with Strubbe and Ishii to obtain the above feature of claim 1. Contrary to the Examiner’s assertion, it is respectfully submitted that it would not have been obvious to one of ordinary skill in the art to modify the teachings of Knee with Strubbe and Ishii in the manner apparently proposed by the Examiner. In this regard, reference is made to In re Fritch, (23 USPQ 2d 1780-CAFC 1992) in which the Court states at page 1783:

“Obviousness cannot be established by combining the teachings of the prior art to produce the claimed

invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined *only* if there is some suggestion or incentive to do so'. Although couched in terms of combining teachings found in the prior art, the same inquiry must be carried out in the context of a purported obvious 'modification' of the prior art. **The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification....It is impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious.** This court has previously stated that '[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention". (Underlining and bold added for emphasis.)

There does not appear to be any suggestion in Knee, Strubbe, and Ishii as required by the Court in In Re Fritch, to modify their teachings in the manner suggested by the Examiner. However, if the Examiner disagrees therewith, it is respectfully requested that the Examiner identify where in Knee, Strubbe, and Ishii there is such suggestion.

Furthermore, it is respectfully submitted that if Knee, Strubbe, and Ishii were combined without the benefit of impermissible hindsight reconstruction, one would not specifically obtain the above feature of claim 1. That is, in the above feature of claim 1, several items (i.e., the information pertaining to the respective recording medium on which the respective program is recorded, the respective start position and end position thereof on the respective recording medium, and the command area) "are all **simultaneously** displayable on a **single** image so as to be viewable by the user." Without the benefit of impermissible hindsight reconstruction, these items (even if disclosed in any of Knee, Strubbe, and Ishii) may be displayed in multiple images.

Accordingly, amended claim 1 is believed to be distinguishable from a proper combination of Knee, Strubbe, and Ishii.

For reasons similar to those described above with regard to claim 1, amended independent claim 4 is also believed to be distinguishable from a proper combination of Knee, Strubbe, and Ishii.

Claims 2, 5-10, 12, and 16 are dependent from one of independent claims 1 and 4 and, due to such dependency, are also believed to be distinguishable from a proper combination of Knee, Strubbe, and Ishii for at least the reasons previously described.

In the event that the Examiner disagrees with the foregoing comments concerning the disclosures of the cited prior art, it is requested that the Examiner indicate where in the reference or references, there is the bases for a contrary view.

In view of the foregoing, entry of this amendment and these remarks and withdrawal of the rejection of claims 1, 2, 4-10, 12 and 16 and the allowance of this application with claims 1, 2, 4-10, 12 and 16 are respectfully requested.

Please charge any fees incurred by reason of this response and not paid herewith to Deposit Account No. 50-0320.

Respectfully submitted,
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